

**Application Number 10/582,693**  
**Amendment dated January 25, 2008**  
**Response to Office Action dated July 27, 2007**

### **REMARKS/ARGUMENT**

Claims 1-13 and 15-17 are pending in the application with all claims having been amended, and claims 14 and 18-20 having been canceled. Claim 1 has been amended to incorporate the features of former claim 14.

Claims 1-12, 16, 19, and 20 have been rejected under 35 U.S.C. 102(b) as being anticipated by Cooke et al. (U.S. Patent No. 6,821,992).

Claims 1-12, 16, 19, and 20 have also been rejected under 35 U.S.C. 103(a) as being unpatentable over Cooke et al.

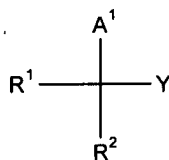
Claims 1-12, 14-17, 19, and 20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Moloney et al. (WO 99/42447).

It is noted that no rejections based upon the cited art have been applied to claim 18.

The features of claim 18 have been incorporated into claim 17 and claim 18 has been canceled, thus effectively rendering claim 17 as former claim 18 rewritten in independent form.

Accordingly, it is requested that the rejection of claim 17 under 35 U.S.C. 103(a) as being unpatentable over Moloney et al. be withdrawn.

Cooke et al. disclose compounds of general formula I,



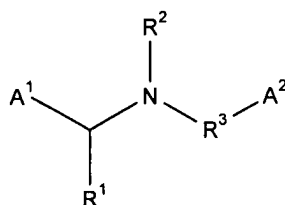
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where  $A^1$ ,  $R^1$ ,  $R^2$  and  $Y$  are as defined in the description; and to their use as phytopathogenic fungicides.

Moloney et al. disclose compounds of formula (I)



and salts thereof as phytopathogenic fungicides wherein  $A^1$  is substituted 2-pyridyl;  $A^2$  is optionally substituted phenyl;  $R^3$  is  $-(C=O)-$ ,  $-SO_2-$  or  $-(C=S)-$ ;  $R^1$  is hydrogen, optionally substituted alkyl or acyl; and  $R^2$  is hydrogen or optionally substituted alkyl are useful phytopathogenic fungicides.

**Novelty over WO 01/11965 (Cooke et al.)**

The examiner has stated in the office action dated 16 July 2007:

"The difference between the Cooke et al compounds and the instantly claimed compounds is the position of the  $R^b$  group on the phenyl ring. The prior art compounds contain a  $R^b$  group at a position other than the 2-position and these compounds are positional isomers of the instant compounds."

The Applicants respectfully disagree with the Examiner's estimation. As it becomes evident from compound No. 310, Cooke et al. also disclose compounds that contain an  $R^b$  group in 2-position.

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However, the present claims (as amended) are novel over Cooke et al. since compounds according to formula (1) wherein R<sup>3</sup> and R<sup>4</sup> are selected from the group consisting of a *hydrogen atom, a halogen atom, a cyano group, a C<sub>1</sub>-C<sub>6</sub>-alkyl, a C<sub>1</sub>-C<sub>6</sub>-halogenoalkyl having 1 to 5 halogen atoms, C<sub>1</sub>-C<sub>6</sub>-alkylcarbonylamino or a phenyl group* are not disclosed by the reference.

**Obviousness over WO 01/11965 (Cooke et al.)**

The following table clearly demonstrates the improved activity of Compound No. 43 according to the present invention (Example 1) as compared to Compound No. 310 of WO 01/11965 (Cooke et al.) (Comparative Example A).

This finding would not have been rendered obvious for the skilled person by any of the prior art references cited.

**Obviousness over WO 99/42447 (Moloney et al.)**

The present invention is distinguished over WO 99/42447 (Moloney et al.) by the fact that the alkylene group between the pyridinyl group and the amide moiety is a substituted ethylene group.

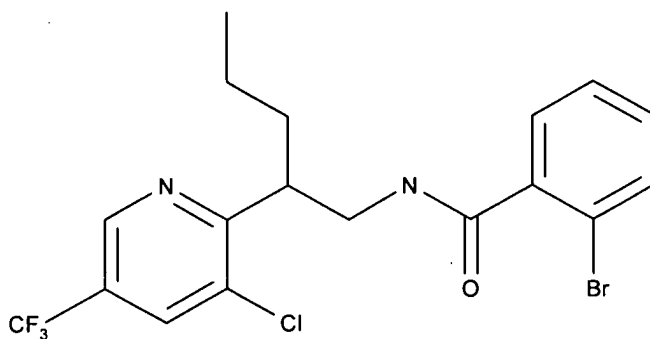
The table also compares the efficacies of Compound No. 43 according to the present invention with Compound No. 20 of Moloney et al. against *alternaria brassicae* and *pyrenophora teres*. It is evident from these examples that the distinguishing feature surprisingly leads to an improvement in terms of fungicidal efficacy.

Again, this finding would not have been rendered obvious for the skilled person by any of the prior art references cited.

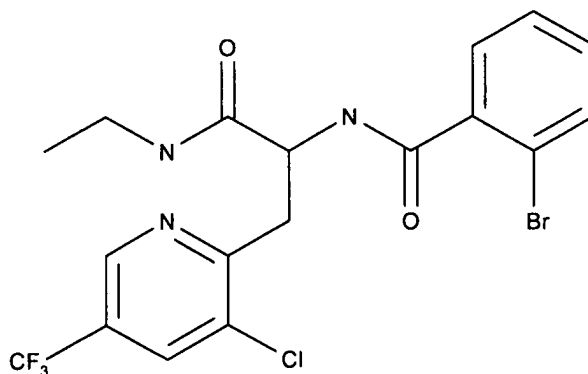
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Example	Compound	<i>Alternaria brassicae</i>	<i>Pyrenophora teres</i>
Example 1 (Present Invention)	No. 43	Good protection (75%) at 125 g/ha	Good protection (78%) at 125 g/ha
Comparative Example A (Cooke et al.)	No. 310	Weak protection (55%) at 125 g/ha	Not tested.
Comparative Example B (Moloney et al.)	No. 20	Weak protection (30%) at 125 g/ha	No protection (0%) at 125 g/ha

The structure of Compound No. 43 is:

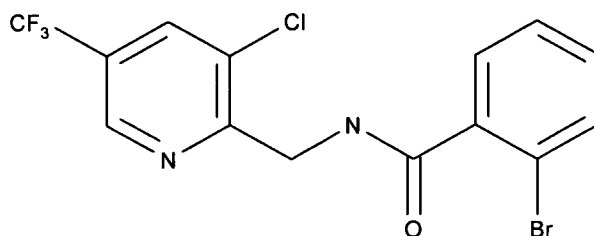


The structure of Compound No. 310 is:



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The structure of Compound No. 20 is:



Accordingly, it is requested that the rejections of:

claims 1-12, 16, 19, and 20 under 35 U.S.C. 102(b) as being anticipated by Cooke et al.;

claims 1-12, 16, 19, and 20 under 35 U.S.C. 103(a) as being unpatentable over Cooke et al.; and

claims 1-12, 14-17, 19, and 20 under 35 U.S.C. 103(a) as being unpatentable over Moloney et al.

be withdrawn.

Claims 1-20 have been rejected under 35 U.S.C. 112, first paragraph, because, according to the Examiner, the specification, while being enabling for using the compounds of formula I with X equal to hydrogen or CF<sub>3</sub>; R<sup>1</sup> and R<sup>2</sup> equal to hydrogen, C<sub>1</sub>-C<sub>6</sub> alkyl, or benzyl; or R<sup>3</sup> and R<sup>4</sup> equal to a hydrogen atom or a carbamoyl group or C<sub>1</sub>-C<sub>6</sub> alkyl, or phenyl; and R<sup>5</sup> equal to hydrogen or C<sub>3</sub>-C<sub>7</sub> cycloalkyl; or Y equal to hydrogen or a halogen or C<sub>1</sub>-C<sub>8</sub> alkyl, or C<sub>1</sub>-C<sub>8</sub> alkoxy, or R<sup>b</sup> equal to C<sub>1</sub>-C<sub>6</sub> alkyl, or C<sub>1</sub>-C<sub>6</sub> halogenoalkyl having 1 to 5 halogen atoms or C<sub>1</sub>-C<sub>6</sub>

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alkoxy, or C<sub>1</sub>-C<sub>6</sub> alkylamino, does not reasonably provide enablement for using the compounds with X, R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup>, R<sup>4</sup>, R<sup>5</sup>, and Y equal to all other moieties claimed.

This rejection is respectfully traversed.

All of the claims remaining in the application are directed to *compounds* and to a method for making them. The specification discloses *utility* for these compounds as fungicides, but the claims are not directed to the *use* of the compounds as fungicides. When a composition of matter, e.g., a compound, is the subject of an invention, it is only required that a utility for the compound be disclosed, which has been done here. Indeed, a significant number of examples of compounds within the scope of the claims have been presented along with showings of their effectiveness. It is submitted that more than this is not required where the novel and unobvious compounds and a method for making them are being claimed, rather than the use of such compounds as fungicides. It is possible that compounds within the scope of the present invention may have entirely different uses that have not as yet been discovered. This, however, should not put limitations on the scope of the compounds being claimed.

"The determination of the propriety of a rejection based upon the scope of a claim relative to the scope of the enablement involves two stages of inquiry. The first is to determine how broad the claim is with respect to the disclosure. The entire claim must be considered. The second inquiry is to determine if one skilled in the art is enabled to make and use the entire scope of the claimed invention without undue experimentation. ...

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In *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976), the court stated:

[T]o provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts." MPEP 2164.08.

Here, the determination of whether the experimentation required to make and use the claimed invention is undue should be directed to what experimentation, if any, is needed to *make the compounds claimed*, and *not* to how all such compounds might be employed as fungicides.

Accordingly, it is requested that the rejection of claims 1-20 under 35 U.S.C. 112, first paragraph, be withdrawn.

In view of the foregoing, it is submitted that this application is in condition for allowance and an early Office Action to that end is earnestly requested.

Respectfully submitted,



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